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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/557,118

Applicant(s)

CZYSZCZEWSKI ET AL.

Examiner

David L Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-37 is/are pending in the application.
- 4a) Of the above claim(s) 5-8, 10-12, 18-20 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 13-17, 21 and 25-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 3/12/2004 was filed after the mailing date of the first action on the merits on 11/6/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Response to Amendment***

2. The amendment filed on 3/9/2004 has been received and made of record. Claims 1-8, 10-12, 18-20, and 22-24, have been cancelled, claims 36-37 have been added. Claims 9, 13-17, 21, and 25-37 are pending.

### ***Response to Arguments***

3. Applicant's arguments, see page 16, filed 3/9/2004, with respect to the drawings have been fully considered and are persuasive. The objection of drawings has been withdrawn.

4. Applicant's arguments with respect to claims 9, 13-17, 21, and 25-37 have been considered, but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 9, 13-17, 21, and 25-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-27 of U.S. Patent No. 6,577,907. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

**Regarding claim 9** of the instant application is incorporated into claims 4 and 5 of patent 6, 577, 907. In claim 9, the wording "an image capture device which generates a digital record" is obviously interpreted as in claim 4 of patent 6, 577, 907, "a scanner interface coupling at least one scanner and generating a digital record of a scanned image". The wording "a printer interface which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer; a controller which couples said image capture device and said printer interface, said controller having a first network interface which connects to an area network for bidirectional exchange of digital data; and a second network interface which connects to a second network for bidirectional exchange of digital data; and a control program stored accessibly to and executable on said controller, said control program when executing enabling a user to select delivery of the digital record to a selected one of said printer interface, said first network interface, and said

second network interface” are an obvious variation of claim 4. Further, with claim 5 added to claim 4, it is the entire claim 9.

**Regarding claim 13**, the only variation between the instant application claim 9 is the phrase “to any selected two of said printer interface”. Which is found in claim 6 of patent 6, 577, 907, and the remainder of claim 13 is the combination of claims 6 and 7.

**Regarding claim 14** of the instant application is an obvious variation of claim 8 in patent 6, 577, 907.

**Regarding claims 15-17**, which is dependent on independent claim 14, they are identical in wording to claims 11-13 respectively, of patent 6, 577, 907.

**Regarding claim 21**, it is an obvious variation of a combination of claims 10 and 13 of patent 6, 577, 907.

**Regarding claim 25**, it is an obvious variation of combined claims 14 and 17 of patent 6, 577, 907.

**Regarding claim 26** of the instant application is an obvious variation of claim 18 in patent 6, 577, 907.

**Regarding claims 27-29**, which is dependent on independent claim 26, they are identical in wording to claims 19-20 respectively, of patent 6, 577, 907.

**Regarding claim 30**, it is an obvious variation of claim 22, of patent 6, 577, 907. The difference between the two claims in step 2, the newly added phrase “which contains the digital record”, it would be obvious to one of ordinary skill in the art at the time the invention was made that original claim incorporates the meaning that when an email is generated from the delivered record that it would obviously contain the digital record in some fashion. Therefore, it is shown

that in claim 22 of patent 6, 577, 907, that step 2 incorporates all of the meaning of instant application claim 30, step 2.

**Regarding claim 31**, which is dependent on independent claim 30, it is identical in wording to claim 23, of patent 6, 577, 907.

**Regarding claim 32**, it is an obvious variation of claim 24, of patent 6, 577, 907. The difference between the two claims in step 2, the newly added phrase “which contains the digital record”, it would be obvious to one of ordinary skill in the art at the time the invention was made that original claim incorporates the meaning that when an email is generated from the delivered record that it would obviously contain the digital record in some fashion. Therefore, it is shown that in claim 24 of patent 6, 577, 907, that step 2 incorporates all of the meaning of instant application claim 32, step 2.

**Regarding claim 33**, which is dependent on independent claim 32, it is identical in wording to claim 25, of patent 6, 577, 907.

**Regarding claim 34** of the instant application is an obvious variation of claim 26 in patent 6, 577, 907.

**Regarding claim 35**, it would be obvious one skilled in the art that the system would incorporate a program to operate the system claimed in claim 32.

**Regarding claims 36 and 37**, it would be obvious one skilled in the art that the methods and system of previous claims would be incorporated to form claims 36 and 37 respectively, for instance, combinations of claims 14, 17, and 35. Therefore, they would be an obvious combination of claims 8, 13, and 32 of patent 6, 577, 907.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 13-17, 21, and 25-30, 32, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 6,246,487) and further in view of Oseto (US 6,097,797).

**Regarding claim 9**, Kobayashi et al. teaches an apparatus that comprises:

An image capture device (scanner, fig. 3, #201, column 8, lines 16-26), which generates a digital record;

a printer interface (printer, fig. 4, #202, column 8, lines 16-26), which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;

a controller (equipment state managing part, fig. 2, #27, column 6, lines 24-39), which couples said image capture device and said printer interface said controller having a first network interface (fig. 8, LAN #500), which connects to an area network for bidirectional exchange of digital data; in figure 8 shows an sample picture of a typical LAN as taught by Kobayashi, which includes a server 3, multifunction unit 2, and client 4;

and a second network interface (fig. 9, #500-2) which connects to a second network for bidirectional exchange of digital data; as seen in figure 9, the system has four separate networks connected by a central network hub #510; in column , lines 46-63, it is taught that the print data

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is transferred to the server 3, which is coupled to computer 4 via LAN 500, but the server 3 to which the print data is transferred does not have to be coupled to the LAN 500. In the case of the network system shown in FIG. 9, the print data may be transferred for example from the computer 4 which is coupled to the LAN 500-1 to the server 3 of the composite apparatus 1 which is coupled to the remote LAN 500-4 via the network 510. In addition, the notifying destination of the print result does not have to be the computer 4, which makes the print request, and may be any computer 4 or any composite apparatus 1 within the network system shown in FIG. 9, for example. Furthermore, the notifying destination of the print result may be set in advance to an address peculiar to each print driver 42 or each print processor 31, and in this case, it is possible to give a priority to a notifying destination which is input from the screen 421 of the print driver 42 if such an input is made. As taught by Kobayashi that since a user is able to send to all of the different areas with in the network, i.e. printer, client , server of network 500-1, but also to 500-4, therefore, it is shown that Kobayashi is doing what is claimed *for selecting delivery of the digital record to any selected one of said printer, said first network interface, and said second network interface.*

Kobayashi teaches that in column 6, lines 24-39, that the system contained within the multifunctional unit can be realized by a combination of one or plurality of processors such as a CPU, and a memory which stores data and programs to be executed by the processor. It would have been obvious to one of ordinary skill in the art at the time the invention was made that although, Kobayashi teaches (column 12, lines 17-38) that the address database 381 that is accessed from the multifunctional unit 2 is contained within the server 3, it would be obvious that one could be stored in multifunctional unit 2 memory as shown by Oseto.



Oseto teaches in column 6, lines 46-67 that the system contains an exemplary structure of the network facsimile apparatus 100 is explained with reference to FIG. 2. The network facsimile apparatus 100 includes a system controller 1, a system memory 2, a parameter memory 3, a clock circuit 4, a scanner 5, a printer 6, a display panel unit 7, an encoding/decoding unit 8, an image memory 9, a Group 3 facsimile modem 10, a network controller 11, a LAN (local area network) interface 12, a LAN (local area network) data transmission controller 13, and an internal bus 14. The system controller 1 controls the operation of the network facsimile apparatus 100 including a facsimile data transmission control for transmitting and receiving image information and arbitrary data files. The system memory 2 stores control (or application) programs to be performed by the system controller 1 and various kinds of data necessary for the execution of the control programs. In addition, the system memory 2 includes *an address conversion table 2a*, and a working memory area reserved for use of the system controller 1. The parameter memory 3 stores various kinds of parameters and information specific to the network facsimile apparatus 100. Further, Oseto teaches in column 7, lines 45-56, that the address conversion table 2a of fig. 3, includes the email address of recipients.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internal address list of Oseto within the memory of Kobayashi.

The suggestion/motivation for doing so would have been to provide the ability to send and receive email to and from other terminals machines through the LAN, without utilizing a system server for database information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Oseto with Kobayashi to obtain the invention as specified in claim 9.

**Regarding claim 13**, Kobayashi et al. teaches an apparatus that comprises:

An image capture device (scanner, fig. 3, #201, column 8, lines 16-26), which generates a digital record;

a printer interface (printer, fig. 4, #202, column 8, lines 16-26), which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;

a controller (equipment state managing part, fig. 2, #27, column 6, lines 24-39), which couples said image capture device and said printer interface said controller having a first network interface (fig. 8, LAN #500), which connects to an area network for bidirectional exchange of digital data; in figure 8 shows an sample picture of a typical LAN as taught by Kobayashi, which includes a server 3, multifunction unit 2, and client 4;

and a second network interface (fig. 9, #500-2) which connects to a second network for bidirectional exchange of digital data; as seen in figure 9, the system has four separate networks connected by a central network hub #510; in column , lines 46-63, it is taught that the print data is transferred to the server 3, which is coupled to computer 4 via LAN 500, but the server 3 to which the print data is transferred does not have to be coupled to the LAN 500. In the case of the network system shown in FIG. 9, the print data may be transferred for example from the computer 4 which is coupled to the LAN 500-1 to the server 3 of the composite apparatus 1 which is coupled to the remote LAN 500-4 via the network 510. In addition, the notifying

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destination of the print result does not have to be the computer 4, which makes the print request, and may be any computer 4 or any composite apparatus 1 within the network system shown in FIG. 9, for example. Furthermore, the notifying destination of the print result may be set in advance to an address peculiar to each print driver 42 or each print processor 31, and in this case, it is possible to give a priority to a notifying destination which is input from the screen 421 of the print driver 42 if such an input is made. As taught by Kobayashi that since a user is able to send to all of the different areas with in the network, i.e. printer, client , server of network 500-1, but also to 500-4, therefore, it is shown that Kobayashi is doing what is claimed *for selecting delivery of the digital record to any selected two or said printer, said first network interface, and said second network interface.*

Kobayashi teaches that in column 6, lines 24-39, that the system contained within the multifunctional unit can be realized by a combination of one or plurality of processors such as a CPU, and a memory, which stores data and programs to be executed by the processor. It would have been obvious to one of ordinary skill in the art at the time the invention was made that although, Kobayashi teaches (column 12, lines 17-38) that the address database 381 that is accessed from the multifunctional unit 2 is contained within the server 3, it would be obvious that one could be stored in multifunctional unit 2 memory as shown by Oseto.

Oseto teaches in column 6, lines 46-67 that the system contains an exemplary structure of the network facsimile apparatus 100 is explained with reference to FIG. 2. The network facsimile apparatus 100 includes a system controller 1, a system memory 2, a parameter memory 3, a clock circuit 4, a scanner 5, a printer 6, a display panel unit 7, an encoding/decoding unit 8, an image memory 9, a Group 3 facsimile modem 10, a network controller 11, a LAN (local area

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network) interface 12, a LAN (local area network) data transmission controller 13, and an internal bus 14. The system controller 1 controls the operation of the network facsimile apparatus 100 including a facsimile data transmission control for transmitting and receiving image information and arbitrary data files. The system memory 2 stores control (or application) programs to be performed by the system controller 1 and various kinds of data necessary for the execution of the control programs. In addition, the system memory 2 includes *an address conversion table 2a*, and a working memory area reserved for use of the system controller 1. The parameter memory 3 stores various kinds of parameters and information specific to the network facsimile apparatus 100. Further, Oseto teaches in column 7, lines 45-56, that the address conversion table 2a of fig. 3, includes the email address of recipients.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internal address list of Oseto within the memory of Kobayashi.

The suggestion/motivation for doing so would have been to provide the ability to send and receive email to and from other terminals machines through the LAN, without utilizing a system server for database information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Oseto with Kobayashi to obtain the invention as specified in claim 13.

**Regarding claim 14**, all parts of the claim have been addressed above in claims 9 and 13, except for the following; Kobayashi teaches a controller (equipment state managing part,

fig. 2, #27, column 6, lines 24-39), which couples said image capture device and said printer interface said controller having a first network interface (fig. 8, LAN #500), which connects to an area network for bidirectional exchange of digital data; in figure 8 shows an sample picture of a typical LAN as taught by Kobayashi, which includes a server 3, multifunction unit 2, and client 4;

and a second network interface (fig. 9, #500-2) which connects to a second network for bidirectional exchange of digital data; as seen in figure 9, the system has four separate networks connected by a central network hub #510; in column , lines 46-63, it is taught that the print data is transferred to the server 3, which is coupled to computer 4 via LAN 500, but the server 3 to which the print data is transferred does not have to be coupled to the LAN 500. In the case of the network system shown in FIG. 9, the print data may be transferred for example from the computer 4 which is coupled to the LAN 500-1 to the server 3 of the composite apparatus 1 which is coupled to the remote LAN 500-4 via the network 510. In addition, the notifying destination of the print result does not have to be the computer 4, which makes the print request, and may be any computer 4 or any composite apparatus 1 within the network system shown in FIG. 9, for example. Furthermore, the notifying destination of the print result may be set in advance to an address peculiar to each print driver 42 or each print processor 31, and in this case, it is possible to give a priority to a notifying destination which is input from the screen 421 of the print driver 42 if such an input is made. As taught by Kobayashi that since a user is able to send to all of the different areas with in the network, i.e. printer, client , server of network 500-1, but also to 500-4, that Kobayashi is doing what is claimed *for selecting delivery of the digital record to each and all of said printer, said first network interface, and said second network interface.*

**Regarding claim 15,** Kobayashi teaches that in column 6, lines 24-39, that the system contained within the multifunctional unit can be realized by a combination of one or plurality of processors such as a CPU, and a memory, which stores data and programs to be executed by the processor. Also, Kobayashi teaches (column 12, lines 17-38) that the address database 381 that is accessed from the multifunctional unit 2 is contained within the server 3.

**Regarding claims 16 and 17,** Kobayashi teaches that in column 6, lines 24-39, that the system contained within the multifunctional unit can be realized by a combination of one or plurality of processors such as a CPU, and a memory, which stores data and programs to be executed by the processor. It would have been obvious to one of ordinary skill in the art at the time the invention was made that although, Kobayashi teaches (column 12, lines 17-38) that the address database 381 that is accessed from the multifunctional unit 2 is contained within the server 3, it would be obvious that one could be stored in multifunctional unit 2 memory as shown by Oseto.

Oseto teaches in column 6, lines 46-67 that the system contains an exemplary structure of the network facsimile apparatus 100 is explained with reference to FIG. 2. The network facsimile apparatus 100 includes a system controller 1, a system memory 2, a parameter memory 3, a clock circuit 4, a scanner 5, a printer 6, a display panel unit 7, an encoding/decoding unit 8, an image memory 9, a Group 3 facsimile modem 10, a network controller 11, a LAN (local area network) interface 12, a LAN (local area network) data transmission controller 13, and an internal bus 14. The system controller 1 controls the operation of the network facsimile apparatus 100 including a facsimile data transmission control for transmitting and receiving image information and arbitrary data files. The system memory 2 stores control (or application)

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programs to be performed by the system controller 1 and various kinds of data necessary for the execution of the control programs. In addition, the system memory 2 includes *an address conversion table 2a*, and a working memory area reserved for use of the system controller 1. The parameter memory 3 stores various kinds of parameters and information specific to the network facsimile apparatus 100. Further, Oseto teaches in column 7, lines 45-56, that the address conversion table 2a of fig. 3, includes the email address of recipients.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internal address list of Oseto within the memory of Kobayashi.

The suggestion/motivation for doing so would have been to provide the ability to send and receive email to and from other terminals machines through the LAN, without utilizing a system server for database information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Oseto with Kobayashi to obtain the invention as specified in claims 16 and 17.

**Regarding claim 21**, although the claim language has changed slightly, i.e. a printer which generates a printed copy derived from the digital record of claim 21 vs. a printer interface, which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer from claim 9. The apparatus identified in claim 9 is performing the same function.

**Regarding claim 25**, although the claim language has changed slightly, i.e. a printer

which generates a printed copy derived from the digital record of claim 25 vs. a printer interface, which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer from claim 13. The apparatus identified in claim 13 is performing the same function.

**Regarding claim 26,** although the claim language has changed slightly, i.e. a printer which generates a printed copy derived from the digital record of claim 26 vs. a printer interface, which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer from claim 14. The apparatus identified in claim 14 is performing the same function.

**Regarding claim 27,** Kobayashi teaches that in column 6, lines 24-39, that the system contained within the multifunctional unit can be realized by a combination of one or plurality of processors such as a CPU, and a memory, which stores data and programs to be executed by the processor. Also, Kobayashi teaches (column 12, lines 17-38) that the address database 381 that is accessed from the multifunctional unit 2 is contained within the server 3.

**Regarding claims 28 and 29,** Kobayashi teaches that in column 6, lines 24-39, that the system contained within the multifunctional unit can be realized by a combination of one or plurality of processors such as a CPU, and a memory, which stores data and programs to be executed by the processor. It would have been obvious to one of ordinary skill in the art at the time the invention was made that although, Kobayashi teaches (column 12, lines 17-38) that the address database 381 that is accessed from the multifunctional unit 2 is contained within the server 3, it would be obvious that one could be stored in multifunctional unit 2 memory as shown by Oseto.



Oseto teaches in column 6, lines 46-67 that the system contains an exemplary structure of the network facsimile apparatus 100 is explained with reference to FIG. 2. The network facsimile apparatus 100 includes a system controller 1, a system memory 2, a parameter memory 3, a clock circuit 4, a scanner 5, a printer 6, a display panel unit 7, an encoding/decoding unit 8, an image memory 9, a Group 3 facsimile modem 10, a network controller 11, a LAN (local area network) interface 12, a LAN (local area network) data transmission controller 13, and an internal bus 14. The system controller 1 controls the operation of the network facsimile apparatus 100 including a facsimile data transmission control for transmitting and receiving image information and arbitrary data files. The system memory 2 stores control (or application) programs to be performed by the system controller 1 and various kinds of data necessary for the execution of the control programs. In addition, the system memory 2 includes *an address conversion table 2a*, and a working memory area reserved for use of the system controller 1. The parameter memory 3 stores various kinds of parameters and information specific to the network facsimile apparatus 100. Further, Oseto teaches in column 7, lines 45-56, that the address conversion table 2a of fig. 3, includes the email address of recipients.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internal address list of Oseto within the memory of Kobayashi.

The suggestion/motivation for doing so would have been to provide the ability to send and receive email to and from other terminals machines through the LAN, without utilizing a system server for database information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Oseto with Kobayashi to obtain the invention as specified in claims 28 and 29.

**Regarding claim 30,** Kobayashi et al. discloses a method comprising the steps of:

capturing a digital record of a document (column 6, lines 50-60);

executing on a controller a control program which enables a user to select delivery of the captured digital record to one of an associated printer, a first network interface, and a second network interface (column 13, lines 24-47); and performing in accordance to such selection one of:

1. delivering the digital record to the printer to generate a copy of the document (fig. 15, #S14, column 20, lines 24-25);

2. delivering the digital record to the first network interface to generate an electronic mail message;

3. delivering the digital record to the second network interface to generate a facsimile transmission to a remote facsimile receiver (column 21, lines 22-67, and column 22, lines 1-23), Kobayashi teaches a method that allows a user to send a document from unit 2 of LAN 5001-1 to unit 2 of LAN 500-4. As shown above the claim dictates that the user to perform a function using one of the selection above, Kobayashi teaches steps 1 and 3, and by the claim language is not required to do step 2.

**Regarding claim 32,** Kobayashi et al. discloses a method comprising the steps of:

capturing a digital record of a document (column 6, lines 50-60);

executing on a controller a control program which enables a user to select delivery of the captured digital record to one of an associated printer, a first network interface(fig. 9, 500-1), and a second network interface (fig. 9, #500-2, 500-3, 500-4, column 13, lines 24-47); and performing in accordance to such selection at least two of:

1. delivering the digital record to the printer to generate a copy of the document (fig. 15, #S14, column 20, lines 24-25);

2. delivering the digital record to the first network interface to generate an electronic mail message, which contains the digital record;

3. delivering the digital record to the second network interface to generate a facsimile transmission to a remote facsimile receiver (column 21, lines 22-67, and column 22, lines 1-23), Kobayashi teaches a method that allows a user to send a document from unit 2 of LAN 5001-1 to unit 2 of LAN 500-4. As shown above the claim dictates that the user to perform a function using two of the selection above, Kobayashi teaches steps 1 and 3, and by the claim language is not required to do step 2.

**Regarding claim 34,** Kobayashi et al. teaches a program product comprising:

a computer readable medium (column 8, lines 30-61);  
a control program (column 8, lines 30-61) stored on said medium, said control program when executing on a controller which couples an image capture device, a printer, and first and second network interfaces, enabling a user to select delivery of a digital record captured by the device to one of the printer, the first network interface (fig. 9, #500-1), and the second network (fig. 9, #500-2, 500-3, 500-4) which connects to a second network for bidirectional exchange of digital data; as seen in figure 9, the system has four separate networks connected by a central network

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hub #510; in column , lines 46-63, it is taught that the print data is transferred to the server 3, which is coupled to computer 4 via LAN 500, but the server 3 to which the print data is transferred does not have to be coupled to the LAN 500. In the case of the network system shown in FIG. 9, the print data may be transferred for example from the computer 4 which is coupled to the LAN 500-1 to the server 3 of the composite apparatus 1 which is coupled to the remote LAN 500-4 via the network 510. In addition, the notifying destination of the print result does not have to be the computer 4, which makes the print request, and may be any computer 4 or any composite apparatus 1 within the network system shown in FIG. 9, for example.

Furthermore, the notifying destination of the print result may be set in advance to an address peculiar to each print driver 42 or each print processor 31, and in this case, it is possible to give a priority to a notifying destination which is input from the screen 421 of the print driver 42 if such an input is made. As taught by Kobayashi that since a user is able to send to all of the different areas with in the network, i.e. printer, client , server of network 500-1, but also to 500-4, therefore, it is shown that Kobayashi is doing what is claimed *for selecting delivery of the digital record to any selected one of said printer, said first network interface, and said second network interface;*

interfaced by performing in accordance to such selection one of:

1. delivering the digital record to the printer to generate a copy of the document (fig. 15, #S14, column 20, lines 24-25);
2. delivering the digital record to the first network interface to generate an electronic mail message, which contains the digital record;
3. delivering the digital record to the second network interface to generate a

facsimile transmission to a remote facsimile receiver (column 21, lines 22-67, and column 22, lines 1-23), Kobayashi teaches a method that allows a user to send a document from unit 2 of LAN 5001-1 to unit 2 of LAN 500-4. As shown above the claim dictates that the user to perform a function using one of the selection above, Kobayashi teaches steps 1 and 3, and by the claim language is not required to do step 2.

**Regarding claim 35,** Kobayashi et al. teaches a program product comprising:

a computer readable medium (column 8, lines 30-61;  
a control program (column 8, lines 30-61) stored on said medium, said control program when executing on a controller which couples an image capture device, a printer, and first and second network interfaces, enabling a user to select delivery of a digital record captured by the device to at least two of the printer, the first network interface (fig. 9, #500-1), and the second network (fig. 9, #500-2, 500-3, 500-4) which connects to a second network for bidirectional exchange of digital data; as seen in figure 9, the system has four separate networks connected by a central network hub #510; in column , lines 46-63, it is taught that the print data is transferred to the server 3, which is coupled to computer 4 via LAN 500, but the server 3 to which the print data is transferred does not have to be coupled to the LAN 500. In the case of the network system shown in FIG. 9, the print data may be transferred for example from the computer 4 which is coupled to the LAN 500-1 to the server 3 of the composite apparatus 1 which is coupled to the remote LAN 500-4 via the network 510. In addition, the notifying destination of the print result does not have to be the computer 4, which makes the print request, and may be any computer 4 or any composite apparatus 1 within the network system shown in FIG. 9, for example.

Furthermore, the notifying destination of the print result may be set in advance to an address peculiar to each print driver 42 or each print processor 31, and in this case, it is possible to give a priority to a notifying destination which is input from the screen 421 of the print driver 42 if such an input is made. As taught by Kobayashi that since a user is able to send to all of the different areas with in the network, i.e. printer, client , server of network 500-1, but also to 500-4, therefore, it is shown that Kobayashi is doing what is claimed *for selecting delivery of the digital record to any selected at least two of said printer, said first network interface, and said second network interface;*

interfaced by performing in accordance to such selection at least two of:

1. delivering the digital record to the printer to generate a copy of the document (fig. 15, #S14, column 20, lines 24-25);

2. delivering the digital record to the first network interface to generate an electronic mail message, which contains the digital record;

3. delivering the digital record to the second network interface to generate a facsimile transmission to a remote facsimile receiver (column 21, lines 22-67, and column 22, lines 1-23), Kobayashi teaches a method that allows a user to send a document from unit 2 of LAN 5001-1 to unit 2 of LAN 500-4. As shown above the claim dictates that the user to perform a function using two of the selection above, Kobayashi teaches steps 1 and 3, and by the claim language is not required to do step 2.

**Regarding claim 36,** Kobayashi et al. teaches an apparatus that comprises:

An image capture device (scanner, fig. 3, #201, column 8, lines 16-26), which generates a digital record;

a printer interface (printer, fig. 4, #202, column 8, lines 16-26), which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer;

a controller (equipment state managing part, fig. 2, #27, column 6, lines 24-39), which couples said image capture device and said printer interface said controller having a first network interface (fig. 8, LAN #500), which connects to an area network for bidirectional exchange of digital data; in figure 8 shows an sample picture of a typical LAN as taught by Kobayashi, which includes a server 3, multifunction unit 2, and client 4;

and a second network interface (fig. 9, #500-2) which connects to a second network for bidirectional exchange of digital data; as seen in figure 9, the system has four separate networks connected by a central network hub #510; in column , lines 46-63, it is taught that the print data is transferred to the server 3, which is coupled to computer 4 via LAN 500, but the server 3 to which the print data is transferred does not have to be coupled to the LAN 500. In the case of the network system shown in FIG. 9, the print data may be transferred for example from the computer 4 which is coupled to the LAN 500-1 to the server 3 of the composite apparatus 1 which is coupled to the remote LAN 500-4 via the network 510. In addition, the notifying destination of the print result does not have to be the computer 4, which makes the print request, and may be any computer 4 or any composite apparatus 1 within the network system shown in FIG. 9, for example. Furthermore, the notifying destination of the print result may be set in advance to an address peculiar to each print driver 42 or each print processor 31, and in this case, it is possible to give a priority to a notifying destination which is input from the screen 421 of the print driver 42 if such an input is made. As taught by Kobayashi that since a user is able to send

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to all of the different areas with in the network, i.e. printer, client , server of network 500-1, but also to 500-4, therefore, it is shown that Kobayashi is doing what is claimed *for selecting delivery of the digital record to each and all of said printer, said first network interface, and said second network interface.*

Kobayashi teaches that in column 6, lines 24-39, that the system contained within the multifunctional unit can be realized by a combination of one or plurality of processors such as a CPU, and a memory, which stores data and programs to be executed by the processor. It would have been obvious to one of ordinary skill in the art at the time the invention was made that although, Kobayashi teaches (column 12, lines 17-38) that the address database 381 that is accessed from the multifunctional unit 2 is contained within the server 3, it would be obvious that one could be stored in multifunctional unit 2 memory as shown by Oseto. Kobayashi et al. discloses a process whereby a print notification is sent by email (column 20, lines 24-25), but does not explicitly detail the ability to send an email, which contains the digital record through the first interface.

Oseto teaches in column 6, lines 46-67 that the system contains an exemplary structure of the network facsimile apparatus 100 is explained with reference to FIG. 2. The network facsimile apparatus 100 includes a system controller 1, a system memory 2, a parameter memory 3, a clock circuit 4, a scanner 5, a printer 6, a display panel unit 7, an encoding/decoding unit 8, an image memory 9, a Group 3 facsimile modem 10, a network controller 11, a LAN (local area network) interface 12, a LAN (local area network) data transmission controller 13, and an internal bus 14. The system controller 1 controls the operation of the network facsimile



apparatus 100 including a facsimile data transmission control for transmitting and receiving image information and arbitrary data files. The system memory 2 stores control (or application) programs to be performed by the system controller 1 and various kinds of data necessary for the execution of the control programs. In addition, the system memory 2 includes *an address conversion table 2a*, and a working memory area reserved for use of the system controller 1. The parameter memory 3 stores various kinds of parameters and information specific to the network facsimile apparatus 100. Further, Oseto teaches in column 7, lines 45-56, that the address conversion table 2a of fig. 3, includes the email address of recipients. And finally, that the email is sent through LAN 012 to mail server SV 102 (column 7, lines 45-56).

It has been shown above the combination of Kobayashi and Oseto allows the user to perform using the system to:

(a) delivering the digital record to the printer to generate a copy of the document (fig. 15, #S14, column 20, lines 24-25);

(b) delivering the digital record to the first network interface to generate an electronic mail message, which contains the digital record (column 11, lines 36-67 and column 12, lines 1-10);

(c) delivering the digital record to the second network interface to generate a facsimile transmission to a remote facsimile receiver (column 21, lines 22-67, and column 22, lines 1-23), Kobayashi teaches a method that allows a user to send a document from unit 2 of LAN 5001-1 to unit 2 of LAN 500-4. Finally, that the combination of Kobayashi and Oseto are performing steps as set down above.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internal address list of Oseto within the memory of Kobayashi.

The suggestion/motivation for doing so would have been to provide the ability to send and receive email to and from other terminals machines through the LAN, without utilizing a system server for database information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Oseto with Kobayashi to obtain the invention as specified in claim 36.

Regarding claim 37, although the claim language has changed slightly, i.e. a printer which generates a printed copy derived from the digital record of claim 37 vs. a printer interface, which generates printed copy signals corresponding to the digital record, the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer from claim 36. The apparatus identified in claim 36 is performing the same function.

### *Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 31 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. and Oseto as applied to claims 9, 13-17, 21, and 25-30, 32, and 34-37 above, and further in view of Brossman et al. U.S. Patent 6,266,150.

Regarding claims 31 and 33, Kobayashi et al. discloses a process whereby a print notification is sent by email (column 20, lines 24-25), Kobayashi et al. does not explicitly disclose that the document itself is to be sent as a text and PDF document within the email document. Oseto teaches the ability to send an email via LAN and mail server, but does not explicitly disclose the ability to choose the format to send the email in of either PDF or text, whereas normal email format to one of ordinary skill in the art at the time the invention was made is text.

Whereas, Brossman et al. teaches (column 11, lines 44-67; column 12, lines 1-20) that there is a wrapper email function that will wrap a bitmap image in a page description language (PDL) such as PDF, and that if the data stream is already in a native format recognized by the target presentation device processing continues to the output device i.e. email text document.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine ability to choose from either a text format or PDF format for delivery of email with the system of Oseto and Kobayashi.

The suggestion/motivation to doing so would have been to include the document in the email notification as a text and PDF, whereby allowing ease of access to the document use and to be designated at step S14 in fig. 15.

Therefore, it would have been obvious to combine Kobayashi and Oseto with Brossman to obtain the invention as specified in claims 31 and 33.

*Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

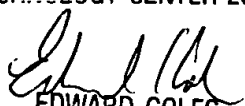
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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